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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,872	07/31/2001	Higashi Yamamoto	Q65630	2059
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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, NW Washington, DC 20037-3213		EXAMINER MOONEYHAM, JANICE A		
		ART UNIT		PAPER NUMBER
		3629		

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/917,872	<b>Applicant(s)</b> YAMAMOTO, HIGASHI	
	<b>Examiner</b> Janice A. Mooneyham	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This is in response to the applicant's communication filed on December 12, 2005, wherein:

Claims 1-18 are pending;

Claims 1-18 have been amended.

**NOTE:** Applicant has identified the application number incorrectly on the amended claim page and the Remarks page. Applicant identifies the application number as 10/917,872. The correct application number is 09/917,872. The Examiner respectfully requests that applicant make the appropriate corrections any further correspondence.

***Information Disclosure Statement***

2. The Examiner is confused by the applicant's request to initial the Information Disclosure Statement filed on August 30, 2002 in light of the comments made by applicant in the IDS filed on November 22, 2002 wherein applicant states the following:

On August 30, 2002, Applicants inadvertently submitted the incorrect Japanese Office Action and reference in the above-referenced case with an Information Disclosure Statement in the above-referenced case. The Examiner is requested to disregard the submission.

Thus, the Examiner signed the IDS and drew a line through the reference as not being considered, as is the policy stated on the form 1449 at the bottom of the page.

***Drawings***

3. The drawings submitted on July 31, 2001 have been entered into the record.

### **Claim Rejections - 35 USC § 112**

The prior rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph is withdrawn.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Based on applicant's Remarks submitted with the December 12, 2005 amendment, the Examiner is unclear what applicant is trying to claim by the added language *base on manipulation of an operator at the death notice accepting section of the public office*. In the Remarks section, on page 19, applicant argues that while Arbuckle discloses a central depository 100 which may receive reports of death form public agencies, and thus may contain "public" information, *it does not entail a public office terminal which based on manipulation of an operator at the death notice accepting section of the public office and which receives reports of death, as recited*. It is unclear what the applicant is trying to claim with this language. Furthermore, what is applicant defining as an operator, what is applicant defining as a public terminal and what does the applicant mean by manipulation? What is applicant identifying a terminal as?

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe et al (US 6, 246, 991) (hereinafter referred to as Abe) in view of Arbuckle (US 5, 651, 117) (hereinafter referred to as Arbuckle).

Referring to Claims 1, 3, 5, 7, 9, 11, 13, 15, and 17-18:

Abe discloses a method, medium (*col. 3, lines 51-54*), and system comprising a testator terminal (*Figure 1 (1) Depositor's terminal*), a last will and testament service terminal (*Figure 1 (20) an electronic information depositing part*), and a communication line (*Figures 1 and 2 (3) network*) for performing last will and testament service, comprising:

producing will information and authentication information (*Figure 2 (11); col. 5, lines 37-43 and Figure 4 (S5)*) in a testator terminal and transmitting via a communication line to a last will and testament service terminal (*col. 3, lines 24-32 the deposit information thus entered is transmitted to the host processing system 10 via the network 3, such as the Internet, and stored in the memory 21 of the electronic information depositing part 20*);

authenticating the testator based on the authentication information at the last will and testament service terminal and registering the will information, taking custody of the will and charging a fee to the testator (*col. 3, lines 58-65 Reference number 11 denotes depositor authentication means for authenticating that an operator who deposits and/or rewrites deposit information using the depositor's terminal (1) is the authorized*

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*depositor; col. 4, lines 3-6 and 37-44; Figure 6; col. 5, lines 7-14 charges for maintaining and managing deposit information; col. 5, lines 61-67) ;*

transmitting updated information and authentication information from the testator terminal to the last will and testament service terminal, the updating being changing, or adding to the contents of the will (*col. 5, lines 64-67 checks authentication information, or whether the electronic key for unsealing is genuine, or whether unsealing by the depositor is an authorized one; col. 5, lines 48-52 when the depositor reads or rewrites the already deposited information, Figure 6 (S14, S15, S16 Registration/Alteration);*

authenticating the testator based on the authentication information; once authenticated, processing the updated information, registering the updated information and charging a fee (*col. 5, lines 53-60 when the depositor has rewritten the deposit information, the rewritten deposit information is stored in the storage area 24; col. 6, lines 33-39 the unsealing part 30 has a function to check whether the adjustment fees for information depositing is paid off);*

comparing the deceased information with the authentication information and if there is a match, transmitting the information to an heir (*col. 3, lines 33-43; col. 6, lines 1-9); and*

when a member's death is confirmed, the system operator enters the information on the death and upon receipt unsealing the deposit information and delivering the information to the recipient –specified (*col. 11, line10 thru col. 12, lines 32).*

Although Abe discloses a memory for storing electronic deposit information (*col. 3, lines 24-37)* Abe does not explicitly disclose a public office terminal or that upon the

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death of the testator, information about the deceased is sent from a public office terminal which accepts the death notice, records it and transmits, via a communication line, the information to the last will and testament service terminal.

However, Arbuckle discloses a public office terminal (*Figure 1 (100) central depository which can be located anywhere; col. 4, lines 27-27*) which upon the death of the testator, information about the deceased is sent from a public office terminal which accepts the death notice, records it and transmits, via a communication line, the information to the last will and testament service terminal (*col. 2, lines 55-64; col. 4, lines 17-23 and lines 60-61 the system provides for a central depository 100 for data storage of information relating to customers who contract with the depository to be notified of the death of a certain person or person when this occurs; col. 5, lines 47-50; Figure 3*). The Examiner asserts that the language of Arbuckle is broad enough to encompass the last will and testament service terminal as being one of the customers who contract with the depository to be notified of a death.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the will management method and system of Abe with the central depository as taught in Arbuckle so that the task of monitoring reports of death is shifted from individuals who perform the task laboriously and imperfectly to a computerized system that accomplishes it with rigor and speed thus providing timely notice of deaths.

Referring to Claims 2, 4, 6, 8, 10, 12, 14 and 16:

Abe discloses wherein the method is performed over the Internet (col. 7, lines 29-31).

### ***Response to Arguments***

6. Applicant's arguments filed December 12, 2005 have been fully considered but they are not persuasive.

The applicant's first argument is that neither Abe nor Arbuckle teach or suggest a *public office terminal, based on manipulation of an operator at the death notice accepting section of the public office.*

The Examiner respectfully disagrees with this assertion and directs the applicant to column 11, lines 10-59) wherein Abe discloses a system operator beginning the unsealing process when the member's death is confirmed.

Examiner notes that Abe does not disclose the terminal as being a public office terminal. However, Abe does disclose the deposit information being stored in a memory of the electronic information depositing part 20 (col. 3, lines 24-37). Moreover, Arbuckle discloses a central depository (Figure 1 (100)) and states that the central depository can be located anywhere (col. 1, lines 17-27).

The fact that applicant identifies the terminal as a public office terminal rather than a central depository would be deemed to be non-functional descriptive data. This data qualifies as descriptive since it is directed to the name or location of the terminal.



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The name or location of the terminal does not functionally relate to the steps of the method or the structure of the system and thus this data does not distinguish the claimed invention from the prior art in terms of patentability (see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994).

As for claim 1, applicant argues that Arbuckle fails to teach or suggest a public office terminal. Applicant argues that the central depository 100 monitors all reports of death arising in a predetermined domain and then transmits them individually to customers who have contracted with the depository to be notified. Applicant further argues that while the central depository may receive reports of death from public agencies, and thus may contain "public" information, it does not central a public office terminal which based on manipulation of an operator at the death notice accepting section of the public office and which receives reports of death. Although this language is unclear, the Examiner will try to address the applicant's argument, as best understood.

First, applicant has not defined what applicant means be a public terminal in the specification. Therefore, given the broadest reasonable interpretation.

The Merriam Webster Online Dictionary found through Onlook.com defines public as:

***public***

Main Entry: <sup>1</sup>**pub·lic** 

Pronunciation: 'p&-blik

Function: *adjective*

Etymology: Middle English *publique*, from Middle French, from Latin *publicus*; akin to Latin *populus* the people

**1 a** : exposed to general view : OPEN **b** : WELL-KNOWN, PROMINENT **c** : PERCEPTIBLE, MATERIAL

**2 a** : of, relating to, or affecting all the people or the whole area of a nation or state <*public law*> **b** : of or relating to a government **c** : of, relating to, or being in the service of the community or nation

**3 a** : of or relating to people in general : UNIVERSAL **b** : GENERAL, POPULAR

**4** : of or relating to business or community interests as opposed to private affairs : SOCIAL

**5** : devoted to the general or national welfare : HUMANITARIAN

**6 a** : accessible to or shared by all members of the community **b** : capitalized in shares that can be freely traded on the open market -- often used with *go*  
- **pub·lic·ness** *noun*

Therefore, the Examiner is interpreting the term public to be a terminal accessible to or shared by all members of the community and the community being those members who have contracted for services.

Secondly, the specification fails to define what an operator is. Therefore, the Examiner is giving the term the broadest reasonable interpretation.

The Merriam Webster online dictionary defines operator as:

**operator**Main Entry: **op·er·a·tor** 1)

Pronunciation: 'ä-p&amp;-"rA-t&amp;r, 'ä-"prA-

Function: *noun*

**1** : one that operates : as **a** : one that operates a machine or device **b** : one that operates a business **c** : one that performs surgical operations **d** : one that deals in stocks or commodities

**2 a** : **MOUNTEBANK, FRAUD** **b** : a shrewd and skillful person who knows how to circumvent restrictions or difficulties

**3 a** : something and especially a symbol that denotes or performs a mathematical or logical operation **b** : a mathematical function

**4** : a binding site in a DNA chain at which a genetic repressor binds to inhibit the initiation of transcription of messenger RNA by one or more nearby structural genes -- called also *operator gene*; compare OPERON

- **op·er·a·tor·less** *adjective*

Thus, broadly, an operator could be a person or it could be the business as an agent that disseminates the reports of death. Furthermore, it appears that applicant is trying to distinguish its invention by having a human manipulate the terminal at the time of death to send the notice. Arbuckle discloses a computer monitoring reports, compares the data identifying the reported deceased with the stored data and if a match is found, the depository retrieves the information relating to customers concerned with the death and transmits a death notice. The Examiner asserts, that, if applicant is claiming the operator to be a human, it would be an obvious modification to provide for a human operator to review and send the information after the match is found. This modification would not destroy the intended functionality of Arbuckle since the computerized system is for the purpose of relieving the task of monitoring reports of

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death from individuals who perform it laboriously and imperfectly to the computerized system that accomplishes it with rigor and speed (col. 2, lines 64-67). Furthermore, applicant has not disclosed that having a human operator provides any advantage, purpose, or solution to a problem.

The Examiner is also giving the term terminal the broadest reasonable interpretation and identifying a terminal as a computer with a memory.

Moreover, as stated above, the fact that applicant identifies the terminal as a public office terminal rather than a central depository would be deemed to be non-functional descriptive data. This data qualifies as descriptive since it is directed to the name or location of the terminal. The name or location of the terminal does not functionally relate to the steps of the method or the structure of the system and thus this data does not distinguish the claimed invention from the prior art in terms of patentability (see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994).

***Conclusion***

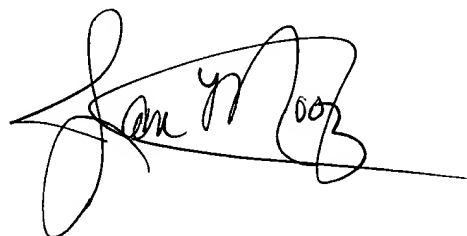
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a long horizontal line extending to the right.

Jan Mooneyham  
Patent Examiner  
Art Unit 3629